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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,005	04/03/2001	Hirotake Watanabe	010368	6459
38834	7590	12/05/2005	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			SORRELL, ERON J	
			ART UNIT	PAPER NUMBER
			2182	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/824,005	Applicant(s) WATANABE, HIROTAKE	
	Examiner Eron J. Sorrell	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/23/05 has been entered.

Election/Restrictions

2. Newly submitted claim 12 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the previously presented independent claims 1,5, and 9 (Invention I), are directed toward a network management system and method classified in 709/223 and newly presented claim 12 (Invention II) is directed toward peripheral device configuration classified in 710/8.

3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for

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patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the specific characteristics of the subcombination are omitted and thus not required by the combination claim. The subcombination has separate utility such as network configurable peripheral device.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 12 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (U.S. Patent No. 6,516,347) in view of Ylonen (U.S. Pub No. 2004/0250072) and further in view of Murphy, Jr. et al (U.S. Patent No. 6,076,110 hereinafter "Murphy").

6. Referring to method claims 1, system claims 5, and apparatus claim 9, Nakamura a network management system (see figure 1) having a plurality of network devices connected to management equipment through a network (see figure 1), said network management system comprising:

management equipment (see item 1 in figure 1) for assigning identification information to each network device (see items labeled "network device" in figure 1) and setting to said each network device (see lines 37-46 of column 4);

wherein said management equipment indicates said network device onto a screen for network device management (see item 2 in figure 1) using the identifier which is the same as said identification information (see lines 55-62 of column 4), and wherein a user is enabled to assign identification information different from the identification information used in the network (see lines 50-54 of column 4, note the user is enabled to enter any identification information).

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Nakamura fails to teach the plurality of network devices for visually outputting said identification information assigned thereto.

Ylonen teaches in an analogous method, the above limitation (see paragraph 38 on page 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Nakamura with the above teachings of Ylonen. One of ordinary skill in the art would have been motivated to make such modification in order for the user to verify the configuration data as suggested by Ylonen (see paragraph 37 on page 3).

The combination of Nakamura and Ylonen fails to teach the limitation of the management equipment managing to indicate the identifier only on a network device, which is requested to indicate the identifier.

Murphy teaches, in an analogous system, the above limitation (see line 51 of column 11 to line 14 of column 12).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Nakamura and Ylonen with the above teachings from Murphy. One of ordinary skill in the art would have been motivated to make such modification in order to fully define a

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network printer and print to it as suggested by Murphy (see lines 4-25 of column 3).

7. Referring to method claim 2, system claim 6, and apparatus claim 10, Nakamura teaches the management equipment retrieves a database having identification information related to each network device (see figures 3 and 4) and automatically assigning a retrieved identification information to each network device (see lines 1-23 of column 7).

8. Referring to method claim 3 and system claim 7, Ylonen teaches displaying the identification information onto an operational panel of the network device (see paragraph 38 on page 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method and system of Nakamura with the above teachings of Ylonen for the same reasons as outlined in the rejection of claims 1 and 5, *supra*.

9. Referring to claim 8, Ylonen teaches the network device is a printer (see paragraph 2 on page 1) and the management equipment is a server (see paragraph 19 on page 2).

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It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Nakamura with the above teachings of Ylonen. One of ordinary skill in the art would have been motivated to make such modification because network printers are widely in use and the use of servers for configuring devices allows for remote configuration as new devices are connected to the network as suggested by Ylonen (see paragraph 9 bridging pages 1 and 2).

10. Referring to method claim 4 and apparatus claim 11, the combination of Nakamura, Ylonen, and Murphy fails to teach the identification information comprises a primary identifier and a secondary identifier respectively includes a color and letter however Ylonen does teach the identifier can be anything suitable to identify the device (see paragraph 19 on page 2) It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Nakamura, Ylonen, and Murphy such that the identification information comprises a primary identifier and a secondary identifier respectively includes a color and letter in order to uniquely distinguish any printers as either color or black and

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white and enumerate printers in each category in order to be able to differentiate one printer from one another.

Response to Arguments

11. Applicant's arguments with respect to claims 1,5, and 9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J. Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EJS
December 1, 2005



KIM HUYNH
PRIMARY EXAMINER

12/01/05